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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,004	03/15/2001	Kentaro Murase	1359.1042	4583
21171	7590	09/13/2004	EXAMINER	
			AKPATI, ODAICHE T	
STAAS & HALSEY LLP		ART UNIT		PAPER NUMBER
SUITE 700				2135
1201 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005				

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/808,004	MURASE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tracey Akpali	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 March 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>05/11/2001</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott et al (6484260 B1).

With respect to Claim 1, the limitation of “a biological information obtaining part for obtaining first biological information on a user at a time of first use of the recording medium; a user registration part for registering the first biological information in the recording medium, considering the user as an owner of the recording medium” is met on column 1, lines 66-67 and on column 2, lines 1-21; and “an owner confirmation part for detecting second biological information on a user at a time of second and later use of the recording medium, and determining whether or not the user using the recording medium is identical with the owner registered in the recording medium, based on the first and second biological information” is met on column 1, lines 51-58. The user registration part is inherent because registration of the user’s biological information necessitates its existence.

With respect to Claim 4, the limitation of “a biological information obtaining part for obtaining first biological information on a user at a time of first use of the recording medium; an

owner registration part for registering the first biological information in a database disposed on a network, considering the user as an owner of the recording medium” is met on column 1, lines 66-67 and on column 2, lines 1-21; and “an owner confirmation part for detecting second biological information on a user at a time of second and later use of the recording medium, and determining whether or not a user using the recording medium is identical with the owner registered in the database, based on the first and second biological information” is met on column 1, lines 51-58. The user registration part is inherent because registration of the user’s biological information necessitates its existence.

With respect to Claim 7, its limitation is similar to Claim 1 limitation and hence its rejection can be found therein.

With respect to Claim 8, the limitation of “obtaining first biological information on a user at a time of first use of the recording medium” is met on column 1, lines 46-51; and “registering the first biological information in a database disposed on a network, considering the user as an owner of the recording medium” is met on column 3, lines 4-8, column 7, lines 15-23; and “detecting second biological information on a user at a time of second and later use of the recording medium, and determining whether or not the user using the recording medium is identical with the owner registered in the database, based on the first and second biological information” is met on column 1, lines 55-58.

With respect to Claim 9, the limitation of “obtaining first biological information on a user at a time of first use of the recording medium” is met on column 1, lines 46-51; and “registering the first biological information in the recording medium, considering the user as an owner of the recording medium” is met inherently on column 1, lines 51-55; and “detecting second biological information on the user at a time of second and later use of the recording medium, and determining whether or not the user using the recording medium is identical with the owner registered in the recording medium, based on the first and second biological information” is met on column 1, lines 51-58.

With respect to Claim 10, its limitation is similar to Claim 9 limitation and hence its rejection can be found therein.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al (6484260 B1) in view of Gressel (6311272 B1).

With respect to Claim 2, Scott et al meets the limitation of “a biological information obtaining part for obtaining first biological information on a user at a time of first use of the

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recording medium” on column 1, lines 66-67 and on column 2, lines 1-21; and “a recording medium reading part for reading information on a use status of the recording medium” is met on column 2, lines 27-33; and “a read data checking part for checking whether or not the recording medium is being used with proper authorization, based on the information on a use status read in the recording medium reading part” is met on column 3, lines 4-19. Scott however does not meet the following limitation. The ID code represents the use status.

The limitation of “a recording medium writing part for writing, in a case of use with proper authorization, the first biological information on the user and the information on a use status of the recording medium in the recording medium; and writing, in a case of use without proper authorization, invalidity information on the recording medium and the information on a use status in the recording medium” is met by Gressel on column 5, lines 10-36, the abstract and Fig. 5A and 5B. The biometric information is updated to reflect a new biometric data taken from an authorized user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gressel within the system of Scott et al because updating the user’s biometric data stored within the system allows the system to operate more accurately based on more specifically relating data to each authorized user. Hence a user’s worn fingerprints are compared to his original fingerprints to see if the new fingerprints are authentic and then the changes are noted and the new information is saved by the system.

With respect to Claim 3, Scott et al meets the limitation of “a user biological information obtaining part for obtaining the second biological information on a user of the recording

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medium" on column 1, lines 51-55; and "a recording medium reading part for reading an identifier of the recording medium, information on a use state of the recording medium, and the first biological information on the user" is met on column 2, lines 27-33, 49-62; and "a use status checking part for checking whether or not the recording medium is being used with proper authorization, based on the information on a use status read in the recording medium reading part" is met on column 3, lines 4-19; and "a similarity determining part for calculating similarity by comparing the second biological information obtained in the user biological information obtaining part with the first biological information read in the recording medium reading part determining authorized use when the similarity exceeds a predetermined threshold value, and determining unauthorized use when the similarity is equal to or lower than a predetermined threshold value," is met on column 1, lines 51-55 and on column 10, lines 29-35. Scott et al however does not meet the following limitation.

The limitation of "a recording medium writing part for writing, in a case of use with proper authorization, the information on a use status and, if required, the second biological information on the user in the recording medium, and writing, in a case of use without proper authorization, invalidity information on the recording medium and the information on a use status in the recording medium" is met by Gressel on column 5, lines 10-36, abstract and on Fig. 5A and 5B.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gressel within the system of Scott et al because updating the user's biometric data stored within the system allows the system to operate more accurately based on more specifically relating data to each authorized user. Hence a user's worn

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fingerprints are compared to his original fingerprints to see if the new fingerprints are authentic and then the changes are noted and the new information is saved by the system.

With respect to Claim 5, Scott et al meets the limitation of “a biological information obtaining part for obtaining first biological information on a user at a time of first use of the recording medium” on column 1, lines 66-67 and on column 2, lines 1-21; and “a recording medium reading part for reading an identifier of the recording medium” is met on column 2, lines 27-33; “a read data checking part for checking whether or not the recording medium is being used with proper authorization, based on the information on a use state extracted from the database, using the identifier read in the recording medium reading part as key information” on column 3, lines 4-19. Scott et al however does not meet the following limitation.

Gressel meets the limitation of “a recording medium writing part for writing, in a case of use with proper authorization, the first biological information on the user and the information on a use status of the recording medium in the database and writing, in a case of use without proper authorization, invalidity information on the recording medium and the information on a use status in the database” on column 5, lines 10-36, abstract and on Fig. 5A and 5B.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gressel within the system of Scott et al because updating the user’s biometric data stored within the system allows the system to operate more accurately based on more specifically relating data to each authorized user. Hence a user’s worn fingerprints are compared to his original fingerprints to see if the new fingerprints are authentic and then the changes are noted and the new information is saved by the system.

With respect to Claim 6, Scott et al meets the limitation of “wherein the owner confirmation part comprises a user biological informal-lion obtaining part for obtaining the second biological information on a user of the recording medium” on column 1, lines 51-55; and “a recording medium reading part for reading an identifier of the recording medium” on column 2, lines 27-33; and “a use status checking part for checking whether or not the recording medium is being used with proper authorization, based on the information on a use status extracted from the database, using the identifier read in the recording medium reading part as key information;” on column 3, lines 4-19 and “a similarity determining part for calculating similarity by comparing the second biological information obtained in the user biological information obtaining part with the first biological information extracted from the database, using the identifier reed in the recording medium reading part as key information, determining authorized use when the similarity exceeds a predetermined threshold value, and determining unauthorized use when the similarity is equal to or lower than a predetermined threshold value” on column 10, lines 29-35. Scott et al however does not meet the following limitation.

The limitation of “a recording medium writing part for writing, in a case of use with proper authorization, the information on a use status and, if required, the second biological information on the user in the database, and writing, in a case of use without proper authorization, invalidity information on the recording medium and the information on a use status in the database” is met by Gressel in the abstract, column 5, lines 10-36 and on Fig. 5A and 5B.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gressel within the system of Scott et al because updating the user's biometric data stored within the system allows the system to operate more accurately based on more specifically relating data to each authorized user. Hence a user's worn fingerprints are compared to his original fingerprints to see if the new fingerprints are authentic and then the changes are noted and the new information is saved by the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracey Akpati whose telephone number is 703-305-7820. The examiner can normally be reached on 8.30am-6.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**Please note the Patent Office will be moving to the Alexandria campus next month.**

The new phone number for myself, Tracey Akpati is (571) 272-3846, my SPE, Kim Vu is (571) 272-3859 and the receptionist is (571) 272-2100.

*H. S. Z*  
*Art 2135*

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